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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,719	07/28/2003	Masaki Hashimoto	1114-185	7087

23117 7590 06/21/2005

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/627,719

Applicant(s)

HASHIMOTO ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attachment, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attachment, paragraph 2.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

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1. The proposed amendment filed on Jun. 2, 2005, to claim 1, adding the limitation that the surface roughness of the conductive substrate is "caused by a cutting process" and the proposed amendment filed on Jun. 2, 2005, to claim 2, adding the limitation of "preparing the conductive substrate so as to have a surface roughness caused by a cutting process so that for the surface roughness caused by the cutting process a maximum peak-to-valley roughness (Ry) . . . (emphasis added)" raise new issues that would require further consideration and/or search because the proposed limitations were not present in the claims when the final rejection was mailed on Mar. 3, 2005.

2. The examiner's refusal to enter the amendments filed on Jun. 2, 2005, to claims 1 and 2 renders applicants' arguments regarding said amendments moot. The rejections of claims 1-6 over JP'556 stand for the reasons of record.

Furthermore, applicants' comments regarding the objection of claims 5 and 6 for further not limiting the subject matter recited in claims 1 and 2 from which they depend, respectively, are not persuasive. Applicants argue that there are differences between claims 1 and 2 and claims 5 and 6. Applicants assert that it is not proper to read limitations from the specification

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into the claims as the Office action appears to do in connection with the improper objection to claims 5 and 6.

However, instant claims 1 and 2 do not define the term "peak count Pc" within the four corners of the claims. When the specification provides definitions for terms appearing in the claims, the specification can be used in interpreting the claims. See In re Vogel, 164 USPQ 619, 622 (CCPA 1970). "When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art." In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). As noted in the final rejection, paragraph 4, page 4, the specification defines the term "peak count Pc" at page 13, lines 4-10. The specification at page 13, lines 4-10, states that "herein, the peak count Pc is an index of the surface roughness according to a parameter PPI defined in JJ911-1986 of the Society of Automotive Engineers (SAE) Standard and is a value obtained by counting the number of peaks having a height of at least the predetermined width of the top point and the bottom point in the reference length described above" (emphasis added). Instant claims 5 and 6 recite that "the peak count Pc is obtained by counting the number of peaks which have a height equal to or more than a predetermined width

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from a top point to a bottom point in a reference length." The definition of the peak count Pc recited in claims 5 and 6 appears to be broader than the definition disclosed in the specification. Furthermore, applicants have not clearly stated how the term "peak count Pc" recited in instant claims 5 and 6 differs from the term "peak count Pc" recited in instant claims 1 and 2 as defined in the instant specification.